

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

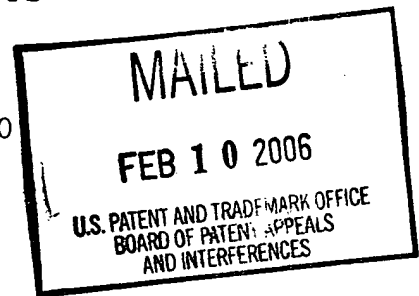
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM PATRICK APPS

Appeal No. 2005-1294
Application No. 09/785,100

ON BRIEF



Before KIMLIN, PAK and TIMM, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

ON REQUEST ON REHEARING

Appellant requests a rehearing of the Board's decision entered August 31, 2005 (hereinafter referred to as "Decision"), wherein we affirmed the examiner's decision rejecting the claims on appeal under 35 U.S.C. § 102(b) and (e).

We have carefully considered the arguments raised by the appellant in the request for rehearing. However, those arguments do not persuade us that our Decision was in error in any respect.

First, the appellant argues that the claimed functional limitations are not taught by the prior art references. See the Request for Rehearing, pages 3 and 4. Specifically, the appellant argues that the prior art references do not teach the claimed functional limitations relating to the size of the display openings (i.e., "sized to reveal labels on the bottle carriers [sic., carriers] for displaying the bottle carriers in a loaded crate") recited in claims 1 and 2 and to the interior shape of the floor or panel (for supporting bottle carriers) recited in claims 1, 2, 15, 16, 28 and 33. *Id.*

As indicated at pages 2 and 7 of the Decision, the claimed subject matter is directed to low depth nestable display crates. This determination is consistent with the examiner's determination at page 10 of the Answer that:

Appellant doesn't broadly claim the combination of a crate and bottle carriers. Appellant's claims are much broader and are directed to the broad invention of a bottle crate intended for use with bottle carriers.

However, rather than reciting the structures of the claimed crates, the appellant relies on functional limitations to define the novel aspect of the claimed crates, e.g., defining the crate in terms of intended use with bottle carriers. See the Decision, page 7. Specifically, we stated (*id.*) that:

The appellant does not dispute the examiner's finding that the prior art references teach low depth nestable crates corresponding to the crates included in claims 1, 15, 28 and 40, except for features [crate structures] defined by the claimed functional limitations relating to [intended use of] bottle carriers.

In other words, the claimed crate structures will vary depending on the precise nature or structure of the bottle carrier encompassed by the claims on appeal.¹ However, as pointed out at pages 2 and 8 of the Decision, the claims on appeal do not limit the structure or shape of the bottle carrier. Nor does the specification limit the structure or shape of the bottle carrier. See the Decision, pages 2 and 8. Thus, relying on *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), we gave the term "bottle carrier" the broadest reasonable interpretation in light of the specification as follows:

[T]he [claim] term "bottle carriers" encompasses a conventional thin plastic web material having circular-shape holes (ring carrier) for bundling and transporting multiple bottles and/or **any other bottle carriers, including those which conform to the shapes of the interior surfaces of the prior art crates relied upon by the examiner.** [Emphasis added].

¹ The appellant recognizes the importance of describing the precise nature of the bottle carriers at page 4 of the Request for Rehearing. However, the appellant does not recite the bottle carrier in a precise manner. See the claims.

This interpretation is consistent with the examiner's determination at page 10 of the Answer that the claimed "[b]ottle carrier refers to any hypothetically designed bottle carrier " See also the Brief, page 3, referring to the examiner's interpretation regarding "hypothetical bottle carriers." Any "hypothetical bottle carriers" also include the conventional ring carrier shown at pages 3 and 4 of the Request for Rehearing. Having interpreted the claims in that manner, we found at pages 8 through 10 of the Decision that the structures of the prior art crates relied upon by the examiner appear to be identical or substantially identical to those included in the claims. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). In other words, the claimed functional limitations relating to intended use of a bottle carrier do not patentably distinguish the display opening size and internal shape of the claimed crates from those of the prior art crates since the claims on appeal do not limit the structure or shape of the type of a bottle carrier employed. Thus, consistent with the holding of *Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432 referred to at page 8 of our Decision, we have properly shifted the burden to the appellant to distinguish the structures of the

claimed crates from those of the prior art crates. However, the appellant still has not demonstrated that the claimed functionally defined display opening size and floor and panel interior surfaces are patentably different from those of the prior art crates. See the Request for Rehearing in its entirety. The appellant's reference to the conventional ring shape carrier is of little or no moment since no structural difference between the claimed crates and the prior art crates has been established. *Id.* In this regard, we also note that the appellant has not addressed our interpretation relating to hypothetical bottle carriers such as those which conform to the shapes of the interior surfaces of the prior art crates relied upon by the examiner. *Id.* That is, since the bottle carrier can be in any shape, including those conformed to the interior surfaces of the prior art crates, and any size label can be attached anywhere in the bottle carrier such that it is visible through the openings of the prior art crates, we observe no patentable distinction between the claimed and prior art crates.

The appellant states that "[c]larification and a chance to further respond is requested, if the Board had envisioned a ring

carrier of a type not discussed." See the Request for Rehearing, page 5. Having agreed with the appellant's description of the conventional ring carrier as indicated *supra*, we need not grant this request.²

The appellant requests that footnote 2 in the Decision "be withdrawn so as not to confuse the record." See the Request for Rehearing, pages 5 and 6. We decline.

As is apparent from the statements in the footnote in question, it is no more than advice to the examiner "in the event of further prosecution." We observe no confusion in the record.

In view of the foregoing, the appellant's request for rehearing is granted to the extent of reconsidering our Decision, but is denied with respect to making any change thereto.

² Even if assuming, *arguendo*, the Decision includes a new ground of rejection, we note the appellant's statement that "[t]he Board's decision constitutes new grounds of rejection warranting re-hearing." See the Request for Rehearing, page 3. This statement indicates that the appellant exercised his option of rehearing the case based on the same record in accordance with 37 CFR § 41.50(b)(2004). Thus, pursuant to 37 CFR § 41.52 (a)(1) (2004), we need not permit further rehearing from a decision on rehearing.

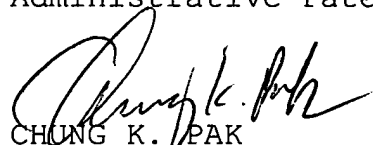
Appeal No. 2005-1294
Application No. 09/785,100

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REQUEST FOR REHEARING - DENIED



EDWARD C. KIMLIN
Administrative Patent Judge



CHUNG K. PAK
Administrative Patent Judge



CATHERINE TIMM
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

CKP:hh

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